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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

05725.0753-00

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/663,183

Filed

September 15, 2000

First Named Inventor

Christine Dupuis

Art Unit

1617

Examiner

G. Mitchell

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Deborah M. Herzfeld  
Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Deborah M. Herzfeld

Typed or printed name

attorney or agent of record.

Registration number 52,211.

202-408-4368

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

January 18, 2006  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Christine DUPUIS ) Group Art Unit: 1617  
Serial No.: 09/663,183 ) Examiner: G. Mitchell  
Filed: September 15, 2000 )  
For: COSMETIC COMPOSITION COMPRISING AT LEAST ) Confirmation No. 4212  
ONE SILICONE/ACRYLATE COPOLYMER AND AT )  
LEAST ONE NONIONIC POLYMER COMPRISING AT )  
LEAST ONE VINYLACTAM UNIT )

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Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In reply to the Final Office Action dated July 19, 2005, the period for response having been extended to January 19, 2006, by the petition for two-month Extension of Time and fee submitted herewith, and pursuant to the July 12, 2005 OG Notice regarding the Pre-Appeal Conference Pilot Program, which has been extended indefinitely pursuant to the January 10, 2006 Notice, Applicant respectfully requests panel review of the outstanding final rejection under 35 U.S.C. § 103(a) identified in the Remarks below. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and completed form PTO/SB/33. No amendments are being filed with this Request.

**REMARKS**

Claims 1-33, 38-82, and 87-102 are pending in this application and stand rejected under 35 U.S.C. § 103(a) "as being unpatentable over Blankenburg et al. (WO/99/04750 translation)

("Blankenburg") in view of Firstenberg et al. (USPN5297566) ("Firstenberg"). Final Office Action at 2.

Applicant traverses the rejection because the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the Examiner must, among other things, point to a suggestion or motivation within the references to modify or to combine reference teachings. See M.P.E.P. § 2143.01. The Examiner has not shown that the cited references provide the requisite teaching or suggestion that would motivate their combination.

The Examiner asserts that Blankenburg teaches “[a] water-dispersible polymer comprising ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives.” Office Action dated Feb. 8, 2005, at 2-3. According to the Examiner, Blankenburg is deficient only in that it “lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, preferred cosmetic mediums, and preferred percent weight.” *Id.* at 3.

The Examiner cites Firstenberg in an attempt to cure the deficiencies of Blankenburg, asserting that “[v]inylpyrrolidone/vinyl acetate/vinyl propionate copolymer is taught and exemplified as a film forming and hair setting polymer useful in the invention disclosed by Firstenberg.” *Id.* at 3-4 (citing Firstenberg at col. 2, lines 41-56; Example 9). The Examiner concludes that “[o]ne would have been motivated to add the hair setting polymer vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Firstenberg et al. to the composition of Blankenburg et al. because of an expectation of similar success in preparing a hair setting composition.” Office Action dated Feb. 8, 2005, at 4. Applicant respectfully disagrees with this conclusion.

The standard in showing obviousness is not whether the references can be combined or modified -- this "does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis added) (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

Further, the suggestion or motivation “must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The Examiner further contends that “(4) Blankenburg et al. teaches [sic] that other cosmetic agents can be added to his composition; and (5) Firstenberg et al. teaches that that more than one hair setting polymer may be used in a hair setting composition.” *Id.* In reality, neither Blankenburg nor Firstenberg suggest the desirability of modifying their respective disclosures to further include the ingredient of the other that the Examiner wishes to combine. For instance, not one of the 16 Examples of Firstenberg shows a composition with more than one film-forming polymer, notably this includes Example 9, which the Examiner relies upon for teaching and providing motivation for the combination of vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers, with another film-forming polymer.

Moreover, in its discussion of the prior art uses of synthetic polymers for hairstyling, Blankenburg states that “[a]t first, vinyl lactam homopolymers and copolymers were preferred, **but subsequently polymers containing carboxylate groups have become increasingly important.**” Blankenburg translation at page 1 (emphasis added). Such a statement in Blankenburg’s disclosure indicates that the invention of Blankenburg is a departure from, and alternative to, vinyl lactam copolymers. The Examiner attempts to rebut this argument by asserting that “[s]imply because Blankenburg et al. states that polymers containing carboxylate groups have become increasingly important does not mean that Blankenburg et al. is teaching that vinyl lactam polymers have become obsolete or even less important.” *Office Action dated Feb. 8, 2005*, at 7.

The issue is not whether vinyl lactam polymers are “obsolete or even less important,” but whether Blankenburg teaches away from their use. The answer to this question is unequivocally yes, as vinyl lactam polymers are part of the art that the teaching of Blankenburg is seeking to avoid. Accordingly, one of ordinary skill in the art would not have been motivated to use those same polymers in combination with Blankenburg. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered.

See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

The "Examiner does not agree that a person of ordinary skill in the art, upon reading the reference, would be discouraged from combining the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of F[ir]stenberg et al. with the polymers of Blankenburg et al. to arrive at a hair setting composition." Final Office Action at 3. Such a statement by the Examiner effectively turns the standard for finding *prima facie* obviousness on its head. The standard is not satisfied merely by stating that an artisan would not be discouraged from combining certain elements. Rather, the standard is for the Examiner to show that the references provide some motivation for a particular combination of references. In order to support a rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would [actively] select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added).

In the present case, the Examiner has not and cannot show that there is a suggestion or teaching in the combined references that would have motivated a person of ordinary skill in the art to subsequently combine the disclosure of Firstenberg, which does not teach vinyllactam polymers with another film-forming polymer, and Blankenburg, clearly teaching an admitted alternative to vinyl lactam copolymers. There is simply no motivation between the two references to make such a selection.

In addition, the Examiner's contention that Blankenburg and Firstenberg "both teach hair care fixative compositions in the for[m] of sprays," does not provide a motivation for modification. *Office Action dated Feb. 8, 2005*, at 4. The Examiner attempts to support his conclusion by stating

it "is obvious to combine two compositions taught by the prior art to be individually useful for the same purpose to form a third composition to be used for that very same purpose." *Id.* at 4-5 (citing *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980)).

*Kerkhoven* is not applicable to the present case. In *Kerkhoven*, the claims at issue were directed to a process for forming a detergent, comprising forming two aqueous detergent slurries, independently or simultaneously drying the slurries, and mixing the resulting products. See *Kerkhoven*, 626 F.2d at 847, 205 USPQ at 1070. Therefore, the court agreed with the examiner's conclusion that the claims at issue required "**no more than the mixing together**" of two conventional detergents to make a third detergent composition set forth "prima facie obvious subject matter." *Kerkhoven*, 626 F.2d at 849, 205 USPQ at 1071 (emphasis added).

There are several key differences between the claimed invention and the invention at issue in *Kerkhoven*. Most notably, the end product in *Kerkhoven* was the same as the two combined ingredients: a detergent. In the claimed invention, the claimed elements are combined to create a solution that can be used to style hair. Moreover, a spray form is not required. See as-filed specification at page 15, lines 9-14. How individual constituents react to form an end product is not akin to *Kerkhoven* and does not support the Examiner's conclusion of obviousness. This position is supported by the fact that the literal combination of Blankenburg and Firstenberg would not give rise to the claimed invention. Thus, the Examiner's application of *Kerkhoven* is inapposite to the present case.

For at least the foregoing reasons, this rejection is in error and Applicant respectfully requests its withdrawal. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 18, 2006  
By: Deborah M. Herzfeld  
Deborah M. Herzfeld  
Reg. No. 52,211